



IFW



Docket No.: 241233US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 10/633,711
Applicants: Katsuhiko MAEDA
Filing Date: August 5, 2003
For: IMAGE FORMING APPARATUS THAT ADJUSTS
IMAGE POSITIONAL DEVIATION WITHOUT FAIL
Group Art Unit: 2854
Examiner: Eugene H. Eickholt

SIR:

Attached hereto for filing are the following papers:

Provisional Election of Species

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 241233US2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KATSUHIKO MAEDA : EXAMINER: EUGENE H. EICKHOLT
SERIAL NO: 10/633,711 :
FILED: AUGUST 5, 2003 : GROUP ART UNIT: 2854
FOR: IMAGE FORMING APPARATUS :
THAT ADJUSTS IMAGE POSITIONAL
DEVIATION WITHOUT FAIL

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement dated July 29, 2004, Applicants provisionally elect with traverse Group A, drawn to Figs. 1-11, and lists Claims 1-5 and 66-70 as readable thereon and at least Claim 1 as generic.¹ Applicants are entitled to consideration of claims, directed to additional non-elected species, which include the limitations of an allowable generic claim, as provided by 37 C.F.R. 1.141(a).

Applicants respectfully traverse the election requirement for the following reasons.

The Election of Species Requirement includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." and lists 25 species. However, the Election of Species Requirement fails to state any basis in support of the finding that the 25 species are patentably distinct. This is contrary to MPEP §816, which states:

¹See the Election of Species Requirement at page 2, line 12, identifying at least Claim 1 as generic.

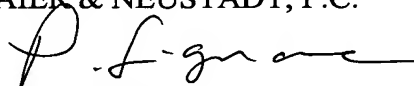
The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given...

In the absence of any annunciated basis, it is respectfully submitted that the Election of Species Requirement fails to establish distinctness.

Furthermore, MPEP 806.04(f) states that "claims to be restricted to different species must recite the mutually exclusive characteristics of such species." However, the Election of Species Requirement fails to show that claims directed to different species are mutually exclusive. Consequently, Applicants respectfully traverse the Election of Species Requirement.

Therefore, Applicants respectfully request that the requirement to elect a single disclosed species be reconsidered and withdrawn,² and that a full examination on the merits of Claims 1-80 be conducted.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
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²See MPEP 821.01.